

Application no. 09/872,737  
Amendment dated: July 10, 2003  
Reply to office action dated: April 10, 2003

## REMARKS

Claims 1-13 are pending in the application. By this paper, claim 12 has been amended. Reconsideration and allowance of claims 1-13 is respectfully requested.

### Claim For Priority

According to the office action, the requirements of 35 U.S.C. § 120 have not been fulfilled for the present application to receive the benefit of the filing date under the statute. According to the office action, the present application does not include at least one common inventor with U.S. application number 09/322,677, now U.S. patent number 6,269,361.

Reconsideration of this determination is respectfully requested. A petition to correct inventorship of U.S. patent number 6,269,361 under 37 CFR 1.324 was submitted on June 12, 2002. Copies of this petition, supporting documents and the stamped return receipt postcard are enclosed herewith. To date, a decision on this petition has not been provided by the USPTO. As evidenced by the enclosed copy of the petition, it is respectfully submitted that the inventor of the present application, Thomas A. Soulanille, is an inventor of U.S. application number 09/3223,677, now U.S. patent number 6,269,361, and the present application is properly a continuation in part of U.S. application number 09/3223,677.

Reconsideration of the claim for priority under 35 U.S.C. § 120 is respectfully requested.

### Information Disclosure Statement

The office action asserts that the Information Disclosure Statement filed January 25, 2002 fails to comply with 37 CFR 1.98(a)(2), but does not specify the deficiencies. The undersigned attorney contacted the examiner of the application by telephone on July 2, 2003 and requested clarification or enumeration of the deficiencies. Applicant renews the request for clarification or enumeration of any noted deficiencies so that they

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may be corrected and the contents of the Information Disclosure Statement may be considered. Applicant respectfully requests that references cited on the Information Disclosure Statement be considered and that the form PTO-1449 be initialed by the examiner and returned to the Applicant.

Objection to the Drawing

The drawings have been objected on the grounds that the drawings must show every feature of the invention specified in the claims. Further, the drawings are objected to based on discrepancies between the specification and the drawing figures.

Submitted with this amendment are replacement sheets including revised drawing figures 10, 12 and 13. In FIG. 12, block 420 has been amended to specify that, after operation of the process illustrated in the drawing figure, the "listings are ordered by a bid-amount weighted random drawing." Support for this amendment to the drawing is found at page 42, lines 3-6 of the application. Further, in FIG. 13, block 474 has been amended to specify that, after operation of the process illustrated in the drawing figure, the "listings are ordered by a bid-rank weighted random drawing." Support for this amendment is found at page 43, lines 22-26.

Other discrepancies noted in the office action have been corrected in the drawing figures or the text. The text has been corrected at page 37 beginning at line 29 so that a variable B is recited, in conformance with the drawing figures 10 and 11. In FIG. 10, a reference defining variable W has been added as block 201 and the text has been amended accordingly at page 36 beginning at line 29. In FIG. 12, block 402 has been amended to conform to the recitation regarding variable V in the text. In FIG. 13, block 452 has been amended to define variable S and the text beginning at page 42, line 33, has been amended accordingly.

Other minor informalities have been corrected in the drawing figures. Accordingly, withdrawal of the objection to the drawing is respectfully requested.

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Objection to the Specification

The specification has been objected to on grounds of several informal matters. Applicant thanks the examiner for the careful review of the application. The noted deficiencies and others noted during a review of the application have been corrected. Applicant has reviewed the entire disclosure and stands ready to make additional corrections to the specification should any other deficiencies be noted. Withdrawal of the objection to the specification is respectfully requested.

Claim rejections under 35 U.S.C. § 112

Claims 7-12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out the subject matter regarded as the invention. According to the office action, the claim terms "random order weighted," "bid amount-weighted random drawing," and "bid rank-weighted random drawing" are not understood. The office action questions, how can the order of the listing be random and weighted at the same time?

This rejection is respectfully traversed. It is submitted that, when considered in light of the specification and drawings, as amended, the noted claim terms are sufficiently clear to provide the requisite definiteness to fulfill the requirements of 35 U.S.C. § 112, second paragraph.

At page 35, beginning at line 1, some of the terminology used in the application is defined:

Each listing that matches a given user search has an associated bid for a user action, e.g. for a clickthrough. The "bid rank" is the rank position of a listing among the set of matching listings sorted in descending order of bid.

The notion of "random order weighting" is explained at page 35, lines 7-17:

In the first of these variations, a predetermined number N of line listing display positions are populated with the N highest bidders, with tie-breaking by seniority. The N line listings appear in the N display positions in random order. The display order may be randomly selected at each display opportunity, or may change periodically or aperiodically. The display order may be re-shuffled every

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time there is a change in tenancy of the display positions, that is, when a line listing moves in or out of the display set. The display order may be re-shuffled every time a web site promoter associated with one of the tenants makes an upward bid, or every time the bid rank of a listing improves, and otherwise be held fixed (as long as tenancy doesn't change).

Thus, N highest-bid display listings are selected. They are ordered randomly for display and may be re-ordered (again, randomly) for subsequent display.

The notion of "bid amount-weighted random drawing"+ is explained in the specification beginning at page 35, line 28:

In a second variation, the N highest-bid display listings are displayed in a randomized order weighted by bid. One method for accomplishing this makes the probability that a given search listing appears first in the search result list proportional to the bid for that search listing. After the first-ranked display position is chosen by a bid-weighted random drawing, the remaining N-1 listings subsequently participate in a similar bid-weighted random drawing for the second-ranked display position, and so forth until the N<sup>th</sup> position, which is occupied by the loser of all the previous drawings.

As noted at page 41, lines 12-14, FIG. 12 and the text accompanying this figure illustrate one embodiment of "listings ... ordered by a random drawing weighted by bid [amount]." Similarly, as noted at page 43, lines 35-26, FIG. 13 and the accompanying text are an example of bid rank-weighted ordering of display listings.

Regarding the notion of a weighted, random listing order, the specification gives examples of how this is achieved. For example, at page 42, lines 6-25, the pseudocode illustrating one embodiment selects a randomly chosen real value and algebraically modifies this random value by a variable V, which is defined to be the sum of the bids of the listings in the selection list. Thus, the random value R is modified or weighted by the value of V. Similarly, at page 43, line 25 to page 44, line 15, in the pseudocode illustrating another embodiment, a random value R is selected and modified or weighted by comparing with a value T. Only when R is less than T or another equivalent test satisfied does processing continue and the display list populated with an entry from the selection list.

Accordingly, it is respectfully submitted that the invention defined by claims 7-12 is recited with the definiteness required by 35 U.S.C. § 112, second paragraph. When

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read in conjunction with the specification, the meaning of the noted claim limitations is sufficiently definite as required by the statute. Withdrawal of the 35 U.S.C. § 112 rejection of claims 7-12 is respectfully requested.

Claim rejections under 35 U.S.C. § 102

Claims 7-13 stand rejected under 35 U.S.C. § 102 (a), (e) as being anticipated by U.S. patent number 6,269,361 to Davis, et al. ("Davis"). This rejection is respectfully traversed.

First, it is submitted that Davis is not prior art under 36 U.S.C. § 102(a). This subsection only relates to knowledge of "others" and to prior patents and printed publications dated before the present application. As noted above, a petition correcting the inventorship of Davis has been filed with the USPTO to add the inventor of the current application as an inventor of Davis, so Davis is not the work of "others" under the statute. Moreover, the present application was filed June 1, 2001, before Davis was issued on July 31, 2001. Accordingly, Davis can only be prior art under 35 U.S.C. § 102(e).

With respect to anticipation by Davis of the invention defined by Independent claims 7, 10 and 13. these claims each recite limitations missing from the disclosure of Davis. Specifically, claim 7 recites

arranging as the search result list the identified search listings for display  
*in a random order weighted according to the bid amount*  
associated with each respective identified search listing;  
*(emphasis added)*

Claim 10 recites

arranging as the search result list the identified search listings for display  
*in a random order weighted according to the bid rank associated*  
with each respective identified search listing; *(emphasis added)*

Claim 13 recites

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*selecting according to bid amount a variable number of identified search listings for display to the searcher, the number of selected identified search listings being a function of the bid amounts for the identified search listings; (emphasis added)*

At least each of the italicized limitations of independent claims 7, 10 and 13 is missing from Davis. Since each of these independent claims recites limitations missing from Davis, this reference can not anticipate the invention defined by these claims. Accordingly, withdrawal of the 35 U.S.C. § 102 rejection of claims 7-13 is respectfully requested. Claim 12 has been amended to correct a minor typographical error noted during review of the claims.

Claim rejections under 35 U.S.C. § 103

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis.

This rejection is respectfully traversed. Under 35 U.S.C. § 103(c), "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This applies to applications filed after November 29, 1999.

The present application was filed June 1, 2001. Davis only qualifies as prior art under subsection (e) of section 102. At the time the present invention defined by claims 1-6 was made, the present application and Davis were assigned to or under obligation of assignment to the present owner, Overture Services, Inc., or its predecessor, Goto.com.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-6 is respectfully requested.

With this response, the application is believed to be in condition for allowance. Should the examiner deem a telephone conference to be of assistance in advancing the

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application to allowance, the examiner is invited to call the undersigned attorney at the telephone number below.

Respectfully submitted,



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